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09/896,886	06/29/2001	Collin P. Galloway	00066CON	1023

7590 01/20/2004  
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EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/896,886

Applicant(s)

GALLOWAY ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/23/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48, 50-90, 91-110 is/are pending in the application.
- 4a) Of the above claim(s) 91-110 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56, 57, 65, 66, 72 and 73 is/are allowed.
- 6) ☒ Claim(s) 1-48, 50-55, 58-64, 67-71, 74, 76, 79 and 81-90 is/are rejected.
- 7) ☒ Claim(s) 75, 77, 78 and 80 is/are objected to.
- 8) ☒ Claim(s) 1-48, 50-110 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's election with traverse of Group Ia, claims 1-90 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that all of the 11 groups fall into class 430 and since each of the claims of these groups require the presence of a modified pigment product having attached at least one organic group, applicants believe that all of the claims may be searched within class 430 without undue burden to the examiner. This is not found persuasive because of the reasons set forth in the last Office Action, and because applicants' allegation that all claims require the presence of a modified pigment product having attached at least one organic group is not true. Claims 23 and 74-82 and claims 93-97 and claims 109-110 do not describe inventions limited to a modified pigment product having attached at least one organic group. 63,000 US documents are classified in Class 430 as of January 11, 2004. In Subclass 138 of Class 430 there are 941 US documents. In Subclass 273.1, there are 885 US documents. Just considering these two subclasses, there is an overlap of only 28 documents. In subclass 273.1, the fragment "pigment" occurs over 460 times. Thus, the examiner believes she has assessed the burden of search appropriately for this application and the restriction requirement set forth in the Office Action of September 17, 2002. With respect to those groups that fall within the same subclass, the issue is that of non-overlapping inventions, i.e. independent inventions. The examiner set forth why she believed these groups to be properly separated.

The requirement is still deemed proper and is therefore made FINAL.

2. With respect to applicant's understanding of citation of references, references cited by the examiner will be made of record but will be noted on the patent issued as having been cited by the examiner. If applicant's do not wish this to occur then they would have to cite the same

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references themselves in the appropriate PTO-1449 while meeting the restrictions set forth with respect to time and fees by making such a citation. As to the date of the Derwent Abstract No. 82-28019E, the examiner has already corrected the record. She notes that courts generally do not recognize English abstracts as having a valid date all the way back to the document abstracted. The abstract is only a published document as of the date it is published. It is evidence however of what might be in the original document. A full, certified English translation of the original document would be preferred if the prior art were to be used in a case on appeal. This is the reason the examiner was careful to note the dates of importance on the PTO 1449 form. The Examiner did not cross out the Abstracts cited; therefore a new PTO 1449 document is not required. The examiner considered the documents as presented and only in the form considered. The documents will be published if this application becomes a patent as they were presented by applicants and further marked by this examiner. If applicants wish a different citation then they should submit the appropriate PTO-1449 and document, if not already of record. It is applicant's discretion as to what they cite in their prior art statements.

3. With respect to applicant's amendments to the specification, the examiner notes that all but those adding "quaternary ammonium compound" to Arquad in paragraphs {0090, 0093, 0104, and 0105] are held not to add new matter to the original disclosure.

4. The amendment filed October 23, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: adding "quaternary ammonium compound" to

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Arquad in paragraphs {0090, 0093, 0104, and 0105} are held not to add new matter to the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action. The examiner notes that if applicants would submit references showing that the Arquad DMHTB was at time of filing that added by applicants then the addition of "quaternary ammonium compound" would be acceptable.

5. With respect to the meaning of "modified pigment product", the examiner notes that as applicant has amended claims 23-24 and 74-82 to further define in each claim what is meant by "modified pigment product". Applicants have also made clear that unless further defined, the term "modified pigment product" references any pigment further modified in any manner. The examiner accepts this and states that the term is clear. Thus, a "modified pigment product" does not require that an organic group be attached unless it is further defined as such when used. The examiner does note for the record that non-elected claims 93-98 require the presence of this "modified pigment product" without further limitation. None of the elected claims are so broad with respect to the "modified pigment product" set forth. In view of applicant's amendments and arguments set forth on pages 24-26 of the Amendment filed October 23, 2003, the examiner withdraws her rejections of claims 23-24 and 74-82 with respect to the meaning of "modified pigment product" under 35 USC 112, second paragraph.

6. Claims 58-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 58-64 reference the radiation-absorptive layer further comprising a polymer. Since claim 56 already comprised a polymer, i.e. the modified pigment product is or at

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least is comprised of a polymer by definition then what further comprising a polymer means is confusing. Further, there is no clear antecedent basis for the polymer being further defined by 59-62 since it is not clear if two polymers or one is present in the narrowest of interpretations of claim 58. Thus, what this claim language means is confusing. EI is the polymer referenced in claim 56. The examiner has assumed for examination purposes applicants intended the polymer of claim 58 to be a polymer separate from the modified pigment product.

7. Claims 67-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 67-71 reference the radiation-absorptive layer further comprising a polymer. Since claim 65 already comprised a polymer, i.e. the modified pigment product is or at least is comprised of a polymer by definition then what further comprising a polymer means is confusing. Further, there is no clear antecedent basis for the polymer being further defined by 68-71 since it is not clear if two polymers or one is present in the narrowest of interpretations of claim 58. Thus, what this claim language means is confusing. SMA is the polymer referenced in claim 65. The examiner has assumed for examination purposes applicants intended the polymer of claim 67 to be a polymer separate from the modified pigment product.

8. Applicant's arguments filed October 23, 2003 have been fully considered but they are not persuasive. With respect to claims 58-64, and 67-71, applicants believe the phrase "further comprises a polymer" to be clear based on their application, but does not state why the polymer that is part of the modified pigment product is not a polymer. Applicant's acceptance of the examiner's statement of what was considered for examination purposes does not act to clarify the claim language set forth. The issue of indefinite wording still exists in these claims. Is the

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"further" polymer a polymer beyond that of the pigment polymer or is the pigment polymer a "further" polymer? These rejections stand.

9. Claims 41-48 and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (WO 99/51690) as evidenced by Grabley et al (WO 98/31550). Johnson et al in Example 15, pages 27-28 and Example 2, page 19 in the making of 2E make a printing plate that has all but the acrylate resins of claims 41-45. However, on page 13-14, Johnson et al teach using a much broader group of materials for their printing plates. The references fully incorporated into Johnson et al include WO98/31550 that is Grabley et al. Grabley et al in Example 6 teach using a pigment mixed with a polyacrylate resin in the radiation absorbing layer and on page 5 other acrylate ester resins as well as (meth)acrylic acid resin are listed as binders for the radiation absorbing pigment layers used in the printing plates set forth. Since Grabley et al is completely incorporated by Johnson et al then the plates of Grabley et al wherein the modified pigments of Johnson et al are used instead of those disclosed Grabley et al make prima facie obvious applicants' printing plates of claims 41-45 because Johnson et al teaches their use together. Wherein the pigments of Johnson et al from page 5, lines 25 to page 6, lines 34, and polymeric groups of polystyrene, styrene copolymers and acrylic polymers are used to modify the pigments, the printing plates of Johnson et al make prima facie obvious applicants' plates of claims 46-48, 52-55. The examiner notes that the date of importance in Johnson et al is October 14, 1999 and it is considered in this 103 (a) rejection via 35 USC 102(a).

10. Claims 41-48 and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (6,336,965 B1) as evidenced by Grabley et al (WO 98/31550). The applied reference has a common inventor with the instant application. Based upon the earlier effective

U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). Johnson et al in Example 15 and Example 2 in the making of 2E make a printing plate that has all but the acrylate resins of claims 41-45. However, in the paragraph bridging col. 11-12, Johnson et al teach using a much broader group of materials for their printing plates. The references fully incorporated into Johnson et al include WO98/31550 that is Grabley et al. Grabley et al in Example 6 teach using a pigment mixed with a polyacrylate resin in the radiation absorbing layer and on page 5 other acrylate ester resins as well as (meth)acrylic acid resin are listed as binders for the radiation absorbing pigment layers used in the printing plates set forth. Since Grabley et al is completely incorporated by Johnson et al then the plates of Grabley et al wherein the modified pigments of Johnson et al are used instead of those disclosed Grabley et al make prima facie obvious



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applicants' printing plates of claims 41-45 because Johnson et al teaches their use together.

Wherein the pigments of Johnson et al from col. 4, line 66 to col. 6, line 4, and polymeric groups of polystyrene, styrene copolymers and acrylic polymers are used to modify the pigments, the printing plates of Johnson et al make prima facie obvious applicants' plates of claims 46-48 and 52-55.

11. Applicant's arguments filed October 23, 2003 have been fully considered but they are not persuasive. Applicants argue that Johnson et al (6,336,965 B1 or WO 99/51690) is improperly combined with Grabley et al (WO 98/31550) with respect to the above rejections because "it would appear the Examiner is picking and choosing specific polymers of Grabley et al to use in Johnson et al. This apparently can only be done with the use of hindsight." Applicants admit that Grabley et al is incorporated in its entirety into Johnson et al, however. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As to picking a choosing, the examiner notes that Johnson points to Grabley et al for conventional additives on page 14 of the WO Johnson document. Thus, the addition of any of the conventional ingredients of Grabley with the elements of Johnson et al would have been prima facie obvious as conventional additions. The rejection stands. With respect to the difference in 6,336,965 B1 or WO 99/51690, the examiner notes it is the date at which each

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reference is applicable. For WO 99/51690, the date is October 14, 1999 and for 6,336,965 B1, the date is April 2, 1999 or considering the provisional document from which it is derived, April 3, 1998. If 6,336,965 B1 were removed as prior art, then the only date to be overcome would be October 14, 1999 in the WO document. This is an issue if applicants attempt to "swear behind" a reference by using 131 affidavits. See particularly MPEP 715.01 for further information on 131 affidavits

12. Claims 23-48 and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (WO 99/51690) in view of Van Damme et al (EP 0 803 771 A2). Johnson et al disclose in SUMMARY OF THE INVENTION that they have provided modified pigment products which are capable of improving the dispersibility and dispersion stability of the pigment in compositions and formulations including those used to manufacture lithographic printing plates such as infrared or near-infrared laser imageable printing plates. The carbon blacks are among those adapted by Johnson et al. Van Damme et al which is cited by Johnson et al on pages 13-14 teach the formation of thermosensitive layers wherein phenolic resins are mixed with pigments like carbon black to form laser imageable layers that become soluble or swellable in aqueous medium. Such resins are inclusive of novolaks which are phenol-formaldehyde polymers, polyvinyl phenols which are polyvinyl hydroxystyrene and polyacrylic acids. With respect to instant claims 23-48 and 50-55, the use of the modified carbon black pigments of Johnson et al in the plates of Van Damme et al would have been obvious to obtain a more stable dispersion of pigment. In Van Damme et al, see particularly Abstract, page 3, lines 35-page 4, lines 20, page 5, lines 10-22.

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13. Claims 23-48 and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (6,336,965 B1) in view of Van Damme et al (EP 0 803 771 A2). The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). ). Johnson et al disclose in SUMMARY OF THE INVENTION that they have provided modified pigment products which are capable of improving the dispersibility and dispersion stability of the pigment in compositions and formulations including those used to manufacture lithographic printing plates such as infrared or near-infrared laser imageable printing plates. The carbon blacks are among those adapted by Johnson et al. Van Damme et al which is cited by Johnson et al in the paragraph bridging col. 11-12 teach the formation of thermosensitive layers wherein phenolic

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resins are mixed with pigments like carbon black to form laser imageable layers that become soluble or swellable in aqueous medium. Such resins are inclusive of novolaks which are phenol-formaldehyde polymers, polyvinyl phenols which are polyvinyl hydroxystyrene and polyacrylic acids. With respect to instant claims 23-48 and 50-55, the use of the modified carbon black pigments of Johnson et al in the plates of Van Damme et al would have been obvious to obtain a more stable dispersion of pigment. . In Van Damme et al, see particularly Abstract, page 3, lines 35-page 4, lines 20, page 5, lines 10-22.

14. Applicant's arguments filed October 23, 2003 have been fully considered but they are not persuasive. Applicants point out that Van Dame (0 803 772 A1) is not cited by Johnson et al (WO/99/51690 or US 6,336,965) but instead Van Damme et al (0 803 771 A2) is. The examiner agrees and for this reason makes the new rejections above. Because of this, the examiner does not make this action final. Applicants argued the combination of Van Damme et al (0 803 771 A2) and Johnson et al anyway. The argument set forth is that the examiner did too much picking and choosing thus practicing hindsight. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicants argue Van Damme et al do not reference the need for improved dispersibility. The examiner agrees but states that it is Johnson et al that teaches the need for improved dispersibility. Applicant's arguments do not

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remove the reason modifying Van Damme et al plates in view of Johnson et al would make obvious the instant invention.

15. The examiner agrees with applicants' arguments with respect to the combination of Adams et al 5,885,335 and Van Damme et al EP 0 803 772 A2 and the currently amended claims 23-35, i.e. the addition of "comprising I) a pigment having attached at least one organic group or ii) a pigment that is coated with one or more polymeric coatings or both....".

16. Claims 1-22 and 83-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Damme et al (EP 0 803 772 A2) or Grabley et al (WO 98/31550) in view of Adam et al (5,698,016). Van Damme et al and Grabley et al teach making the instant printing plates with the exception of using the modified pigment set forth. However, Adams et al teach using the pigment when carbon black in conventional compositions. In Adams et al see particularly col. 7, lines 55-61. With respect to instant claims 1-22 and 83-90, the use of the pigments of Adams et al as the carbon black of Van Damme et al or Grabley et al would have been prima facie obvious to enhance pigment dispersibility as set forth by Adams et al in col. 1. In Adams et al, also see col. 4, 6, and 8. The examiner notes "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103." In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). However, "discovery of the cause of a problem . . . does not always result in a patentable invention. . . . [A] different situation exists where the solution is obvious from prior art which contains the same solution for a similar problem." In re Wiseman, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (emphasis in original). The

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examiner believes it is the In re Wiseman application that applies in this combination of references. Adams et al is directed to the improvement of carbon blacks with respect to dispersion stability. Their approach is taught for all coatings using carbon black generally. Thus the solution is obvious from the prior art which contains the same solution for a similar problem. The rejection stands with respect to claims 1-22 and 83-90.

17. Applicant's arguments filed October 23, 2003 have been fully considered but they are not persuasive. With respect to Claims 1-22 and 83-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Damme et al (EP 0 803 772 A2) or Grabley et al (WO 98/31550) in view of Adam et al (5,698,016), Applicants have argued that Adams et al do not disclose using their modified pigments in printing plates while Grabley et al and Van Damme et al do not teach using the modifications of Adams in their pigments. Thus, there is insufficient reason to combine these references. The examiner believes that the problem to be solved in the instant application as set forth in [0011] in the instant application, i.e. "there is a need for printing plates comprising pigments such as carbon black with improved dispersibility in polymer used to produce printing plates", is a problem well understood in the art of dispersing carbon black and that Adams et al addresses that problem of dispersability in coatings with the same solution as applicants. The examiner believes solution is obvious from the prior art which contains the same solution for a similar problem, i.e. dispersibility of carbon black in a carrier or liquid vehicle. Adams et al in col. 6, lines 36-51 address increased water dispersibility of the modified carbon products and hydrophobic dispersibility in col. 7, lines 14-36. Adams et al also address using composition wherein resins are used as conventional coating additives in col. 8, lines 21-57 wherein acrylic resins are specifically considered. Adams et al in Examples 18a-18n are made by dispersing

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their modified carbon black with acrylate polymers. Thus, the examiner believes the rejection is properly made and repeats it. She does accept that the composition of claim 23 is not made obvious by this combination, however.

18. Claims 74, 76 and 79 and 81-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Sypek et al (5,286,594). In Sypek et al, see particularly the Abstract, co. 1, lines 26-47, Summary of the Invention, col. 4, lines 40- end of col. 5, col. 6, lines 26-45, col. 7, lines 36-56 and Example 1 (57-760002 chip coated with an acrylamide substituted cellulose ester, and mixed in with an acrylamide substituted cellulose ester), Example 2 wherein 79R27C chip is the pigment coated with polyvinylbutyral polymer and is mixed with a cellulose polymer and Example 9 wherein chip 79R84C is used as encapsulated pigment coated with an acrylated polyurethane, i.e. an acrylic polymer, and polyvinylbutyral polymer encasing perylene maroon pigment, and claims. The pigment of Sypek et al is radiation absorptive inherently as evidenced by its being used to produce an color in the lithographic printing plates made. These example plates of Sypek et al anticipate the plates of instant claims 74, 76 and 79 and 81-82 wherein the chips are inherently possessed of coatings that are not extractable by an organic solvent. The coated pigments of Sypek et al are held to be modified pigment products. There is no limit on the modification other than polymer partially or fully coat a pigment and that the polymeric coating is not substantially extractable by an organic solvent.

19. Applicant's arguments filed October 23, 2003 have been fully considered but they are not persuasive. Applicants "believe that, as with conventional dispersant, these can be substantially removed by extraction." Applicants reference the chips of Sypek et al here. They give no

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evidence to support this supposition. The examiner states that the polymers of Sypek et al inherently are not substantially extractable by an organic solvent. The rejection is maintained.

20. Claims 56-57, 65-66 and 72-73 are allowed.

21. Claims 75, 77-78 and 80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

22. Claims 91-110 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Papers filed October 23, 2003 and January 30, 2003.

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cynthia Hamilton whose telephone number is (703) 308-3626. As of December 12, 2003, this telephone number will be 571-272-1331. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff can be reached on 703-308-2464. As of December 12, 2003 this phone number will be 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 0661.*

  
CYNTHIA HAMILTON  
PRIMARY EXAMINER

Primary Examiner Cynthia Hamilton

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January 12, 2004